

ESTTA Tracking number: **ESTTA109623**

Filing date: **11/15/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Proforma, Inc.		
Entity	Corporation	Citizenship	Ohio
Address	8800 E. Pleasant Valley Road Cleveland, OH 44131 UNITED STATES		

Attorney information	Sandra M. Koenig Fay, Sharpe, Fagan, Minnich & McKee, LLP 1100 Superior Avenue, Seventh Floor Cleveland, OH 44114-2579 UNITED STATES skoerig@faysharpe.com, jmoldovanyi@faysharpe.com Phone:216-861-5582
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Applicant Information

Application No	78674183	Publication date	10/17/2006
Opposition Filing Date	11/15/2006	Opposition Period Ends	11/16/2006
Applicant	AmSan, LLC 3 Parkway North Suite 120 Deerfield, IL 60015 UNITED STATES		

Goods/Services Affected by Opposition

Class 037. First Use: 2004/01/30 First Use In Commerce: 2004/01/30 All goods and services in the class are opposed, namely: sanitation consulting
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Attachments	pfmz700063_opp.pdf (13 pages)(448003 bytes)
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Signature	/sandramkoenig/
Name	Sandra M. Koenig
Date	11/15/2006

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application Serial No. 78/674,183
For the mark PROFORMA
Published in the *Official Gazette* on October 17, 2006

Proforma, Inc.,)	
)	
Opposer,)	
)	Opposition No. _____
v.)	
)	
AmSan, LLC,)	
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

Attention: TTAB
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Proforma, Inc., a corporation organized and existing under the laws of the State of Ohio, located and doing business at 8800 E. Pleasant Valley Road, Cleveland, Ohio 44131 (hereinafter referred to as "Opposer"), believes that it will be damaged by the registration of the mark PROFORMA shown in the above-identified application in International Class 37, and hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer has provided goods and services under the PROFORMA mark since at least as early as 1982, and under the virtually identical mark PRO FORMA

since 1978. The company was incorporated under its present name, Proforma, Inc., in 1981.

2. Opposer is in the business of providing a wide range of goods and services to third party businesses. Opposer began providing specialty printing services under PRO FORMA in 1978, and then proceeded to expand and offer other goods and services. Since at least as early as 1982, Opposer has been providing distributorship services in the field of office equipment and office supplies under the PROFORMA mark. Opposer has continued to supply business forms, stationery writing papers, envelopes, folders; ink, fountain and ballpoint pens; lead and mechanical pencils as well as customized printing services under PROFORMA through the present day. Opposer also provides franchising services, advertising services, website design and implementation, as well as an assortment of products used by businesses in both conducting their operations as well as promoting themselves, all under the PROFORMA mark.

3. Opposer, either itself or through its network of over 600 franchisees, regularly calls on third party business entities (customers) and consults with them to provide goods and services for use in conducting the customer's business, and for use in promoting the customer's business, all under the PROFORMA mark. Opposer consults with and helps business entities determine various strategies and solutions for particular situations, and also provides a selection of goods and services the business entity customers may use in operating or promoting their respective businesses. Moreover, Opposer also provides business consulting, cash flow planning and modeling, operational assistance and coaching services to its franchisees.

4. Opposer owns and relies upon the following U.S. trademark registrations (copies of which are attached):

Reg. No.	Mark
1,208,208	PRO FORMA
1,650,434	PROFORMA
1,922,392	PROFORMA
1,567,066	PROFORMA
2,793,865	PROFORMA PROUSA
1,963,905	PROFORMA PRINTING/PROMOTIONS/PRODUCTIVITY
2,817,947	PROFORMA PRINTING PROMOTIONS E-SOLUTIONS
2,712,821	CONNECT WITH THE POWER OF...PROFORMA

5. Opposer's goods and services are provided via a network of more than 600 franchisees located throughout the nation. As a result, Opposer interacts under the PROFORMA mark with an inordinate number of different third party business entities. Customers of Opposer readily recognize Opposer's PROFORMA mark as a source for a wide variety of goods and services used by business customers both in conducting their businesses and promoting their businesses. Opposer, itself and through its franchisees, has developed an exceedingly valuable amount of goodwill with respect to its PROFORMA mark. By virtue of its efforts, and the expenditure of considerable sums on promotional activities and the quality of goods and services provided by Opposer, Opposer has gained for its PROFORMA mark a most valuable reputation.

6. Notwithstanding Opposer's long prior rights in and to the PROFORMA mark for a wide array of goods and services, Applicant, on July 20, 2005, applied to register the identical trademark PROFORMA in association with sanitation consulting services. This application, subject of Serial No. 78/674,183, was published for opposition on October 17, 2006.

7. The PROFORMA mark proposed for registration by Applicant is identical in sight, sound and meaning to Opposer's PROFORMA mark.

8. The services for which Applicant seeks to register its PROFORMA mark are identical to, substantially similar to, or of the same general type of services as those offered under the Opposer's PROFORMA mark. Opposer likewise calls on its customers to provide its goods and services under the PROFORMA mark.

9. The trade channels in which Applicant seeks to provide its PROFORMA services are identical to, substantially similar to, or of the same general nature as the trade channels in which Opposer offers its PROFORMA goods and services.

10. There is no issue as to priority. Opposer has used the PROFORMA mark in providing products and services to a wide variety of businesses since well prior to Applicant's filing date, as well as prior to the date of first use alleged in the application.

11. If Applicant is permitted to register its PROFORMA mark, as specified in the application herein opposed, confusion in the trade resulting in damage and injury to Opposer would be caused and would result by reason of the perception of a relationship between Applicant's services offered under the mark PROFORMA and Opposer's products and services offered under the PROFORMA mark. Relevant consumers may have the impression that the sanitation consulting services offered under Applicant's PROFORMA mark are being marketed, endorsed, approved or sponsored by Opposer. Consumers familiar with Opposer's PROFORMA mark would be likely to purchase or consult with Applicant regarding its sanitation consulting services under the mistaken impression that Applicant's sanitation consulting services are marketed, endorsed, approved, or sponsored by Opposer. Any such confusion in the trade inevitably would

result in the dilution of the goodwill provided by the Opposer. Furthermore, any defect, objection or fault found with Applicant's sanitation consulting services marketed under the PROFORMA mark would unnecessarily reflect upon and seriously injure the reputation which Opposer has established with respect to its products and services associated with its PROFORMA mark and name.

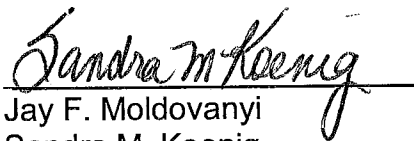
12. Based on the foregoing, registration of the mark PROFORMA depicted in Serial No. 78/674,183, filed July 20, 2005 on the Principal Register, would cause injury and damage to Opposer.

WHEREFORE, Opposer requests that registration of Applicant's mark PROFORMA, application Serial No. 78/674,183, be denied and that this opposition be sustained in favor of Opposer.

Dated: November 15, 2006

Respectfully submitted,

FAY, SHARPE, FAGAN
MINNICH & McKEE, LLP

A handwritten signature in cursive script, reading "Sandra M. Koenig", written over a horizontal line.

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Attorneys for Opposer

Int. Cls.: 16 and 35

Prior U.S. Cls.: 37, 100 and 101

United States Patent and Trademark Office

Reg. No. 1,208,208

Registered Sep. 14, 1982

**TRADEMARK
SERVICE MARK
Principal Register**

PRO FORMA

ProForma Inc. (Ohio corporation)
19007 St. Clair Ave.
Cleveland, Ohio 44117, assignee of
Pro Forma (partnership)
Cleveland, Ohio

For: BUSINESS FORMS, in CLASS 16 (U.S. Cl.
37).

First use Feb. 17, 1978; in commerce Oct. 31, 1978.

For: SPECIALTY PRINTING SERVICES—

NAMELY, DESIGN AND PRINTING OF BUSI-
NESS FORMS FOR OTHERS, in CLASS 35 (U.S.
Cls. 100 and 101).

First use Feb. 17, 1978; in commerce Oct. 31, 1978.

Ser. No. 279,439, filed Sep. 26, 1980.

BRIAN ANDERSON, Primary Examiner

Int. Cl.: 42

Prior U.S. Cl.: 101

United States Patent and Trademark Office

Reg. No. 1,650,434

Registered July 9, 1991

**SERVICE MARK
PRINCIPAL REGISTER**

PROFORMA

PROFORMA INC. (OHIO CORPORATION)
4705 VAN EPPS ROAD
CLEVELAND, OH 44131

FOR: DISTRIBUTORSHIP SERVICES IN THE
FIELD OF OFFICE EQUIPMENT AND SUP-
PLIES AND OFFICE FURNITURE, IN CLASS 42
(U.S. CL. 101).

FIRST USE 4-5-1982; IN COMMERCE
10-0-1985.
OWNER OF U.S. REG. NOS. 1,208,208, 1,567,066
AND OTHERS.

SER. NO. 74-078,219, FILED 7-16-1990.

TINA POMPEY, EXAMINING ATTORNEY

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 1,922,392

United States Patent and Trademark Office Registered Sep. 26, 1995

**SERVICE MARK
PRINCIPAL REGISTER**

PROFORMA

PROFORMA, INC. (OHIO CORPORATION)
4705 VAN EPFS ROAD
CLEVELAND, OH 44131

FOR: ADVERTISING SERVICES, NAMELY
THE SELECTION AND IMPRINTING OF
ITEMS MANUFACTURED BY OTHERS TO BE
USED BY THE CUSTOMER AS GIVE AWAYS,
PROMOTIONAL ITEMS OR FOR SALE, IN
CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 3-0-1994; IN COMMERCE
3-0-1994.

OWNER OF U.S. REG. NOS. 1,208,208, 1,770,389
AND OTHERS.

SER. NO. 74-593,799, FILED 10-12-1994.

CRAIG D. TAYLOR, EXAMINING ATTORNEY

Int. Cls.: 16 and 42

Prior U.S. Cls.: 23, 37, 38 and 100

Reg. No. 1,567,066

United States Patent and Trademark Office Registered Nov. 21, 1989

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**



**PROFORMA INC. (OHIO CORPORATION)
4705 VAN EPPS ROAD
CLEVELAND, OH 44131**

**FOR: BUSINESS FORMS, STATIONERY
WRITING PAPERS, ENVELOPES, FOLDERS;
STAPLERS, STAPLES AND STAPLE REMOV-
ERS; INK, FOUNTAIN AND BALLPOINT
PENS; LEAD AND MECHANICAL PENCILS,
IN CLASS 16 (U.S. CLS. 23, 37 AND 38).**

**FIRST USE 9-24-1984; IN COMMERCE
9-24-1984.**

**FOR: CUSTOMIZED PRINTING SERVICES,
IN CLASS 42 (U.S. CL. 100).
FIRST USE 9-24-1984; IN COMMERCE
9-24-1984.**

**OWNER OF U.S. REG. NO. 1,208,208. —
THE LINING SHOWN IN THE MARK ON
THE DRAWING IS USED TO INDICATE THE
COLORS GREY AND RED.**

SER. NO. 713,414, FILED 2-26-1988.

JEAN E. LOGAN, EXAMINING ATTORNEY

Int. Cls.: 35 and 40

Prior U.S. Cls.: 100, 101, 102, 103 and 106

United States Patent and Trademark Office

Reg. No. 2,793,865

Registered Dec. 16, 2003

**SERVICE MARK
PRINCIPAL REGISTER**

PROFORMA PROUSA

PROFORMA, INC. (OHIO CORPORATION)
8800 E. PLEASANT VALLEY ROAD
CLEVELAND, OH 44131

FOR: PREPARATION OF CUSTOM ADVERTISEMENTS AND CUSTOM PROMOTIONAL PRODUCTS FOR OTHERS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 10-1-2001; IN COMMERCE 10-1-2001.

FOR: CUSTOM IMPRINTING OF CLOTHING, HATS, PINS, MUGS, CALENDARS, GREETING

CARDS, JEWEL CASES FOR COMPACT DISCS WITH BUTTONS, AND GOLF BALLS WITH DECORATIVE DESIGNS; CUSTOMIZED PRINTING OF COMPANY NAMES AND LOGOS FOR PROMOTIONAL ADVERTISING PURPOSES ON THE GOODS OF OTHERS, IN CLASS 40 (U.S. CLS. 100, 103 AND 106).

FIRST USE 10-1-2001; IN COMMERCE 10-1-2001.

SER. NO. 76-410,314, FILED 5-21-2002.

AISHA CLARKE, EXAMINING ATTORNEY

Int. Cls.: 35 and 42

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 1,963,905

Registered Mar. 26, 1996

**SERVICE MARK
PRINCIPAL REGISTER**

PROFORMA PRINTING/PROMOTIONS/PRODUCTIVITY

PROFORMA, INC. (OHIO CORPORATION)
4705 VAN EPPS ROAD
CLEVELAND, OH 44131

FOR: FRANCHISING SERVICES, NAMELY ASSISTANCE IN THE ESTABLISHMENT AND OPERATION OF BUSINESSES SPECIALIZING IN THE SALE AND DISTRIBUTION OF BUSINESS FORMS, OFFICE SUPPLIES, OFFICE EQUIPMENT, PROMOTIONAL PRODUCTS AND COMMERCIAL PRINTING, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 3-0-1994; IN COMMERCE 3-0-1994.

FOR: CUSTOMIZED PRINTING SERVICES; DISTRIBUTORSHIP SERVICES IN THE FIELD

OF OFFICE EQUIPMENT, OFFICE SUPPLIES, OFFICE FURNITURE AND PROMOTIONAL PRODUCTS, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 3-0-1994; IN COMMERCE 3-0-1994.

OWNER OF U.S. REG. NOS. 1,208,208, 1,770,389 AND OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "PRINTING" AND "PROMOTIONS", APART FROM THE MARK AS SHOWN.

SER. NO. 74-593,787, FILED 10-12-1994.

CRAIG D. TAYLOR, EXAMINING ATTORNEY

Int. Cls.: 16, 35, and 42

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38, 50, 100, 101, and 102

United States Patent and Trademark Office

Reg. No. 2,817,947

Registered Feb. 24, 2004

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**

PROFORMA PRINTING PROMOTIONS E-SOLUTIONS

PROFORMA, INC. (OHIO CORPORATION)
8800 E. PLEASANT VALLEY ROAD
CLEVELAND, OH 44131

FOR: BUSINESS FORMS AND DOCUMENTS, NAMELY, ANNOUNCEMENTS, ANNUAL REPORTS, BADGES, BINDERS, BROCHURES, BROCHURE COVERS, BUSINESS CARDS, BUSINESS REPLY CARDS, CALENDARS, CATALOGUES, CERTIFICATES, COUNTER CARDS, COUPONS, COUPON BOOKS, DOOR HANGERS, FLYERS, FOLDERS, FILE FOLDERS, PRESENTATION FOLDERS, GIFT CERTIFICATES, INDEX TABS, INVITATIONS, LETTERHEAD, MAILERS, MANUALS, MEMO PADS, NEWSLETTERS, PAMPHLETS, PARKING TICKETS, POSTERS, PRESSURE TAPE, PROGRAMS, RACK BROCHURES, SELL SHEETS, SOFTWARE DOCUMENTATION, TAGS, TICKETS, TRANSFER TAPE, WALL CALENDARS, BLANK, PARTIALLY PRINTED AND PRINTED LABELS, PAPER TAGS, STATIONARY ENVELOPES, BLANK CHECKS, SALES LEDGER BOOKS, PRINTED TICKET BOOKS AND CASH RECEIPT BOOKS, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 4-0-2003; IN COMMERCE 4-0-2003.

FOR: ADVERTISING SERVICES, NAMELY, THE SELECTION AND IMPRINTING OF ITEMS MANUFACTURED BY OTHERS TO BE USED BY THE CUSTOMERS AS GIVE-AWAYS, PROMOTIONAL ITEMS OR SALE; AND FRANCHISING SERVICES,

NAMELY, ASSISTANCE IN THE ESTABLISHMENT AND OPERATION OF BUSINESSES SPECIALIZING IN THE SALE AND DISTRIBUTION OF BUSINESS FORMS, PROMOTIONAL PRODUCTS AND COMMERCIAL PRINTING, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 9-0-2001; IN COMMERCE 9-0-2001.

FOR: COMMERCIAL PRINTING SERVICES AND BUSINESS ASSISTANCE SERVICES, NAMELY, DESIGNING AND IMPLEMENTING INTERACTIVE ON-LINE WEBSITES FOR OTHERS TO PROVIDE EMPLOYEES AND CUSTOMERS OF OTHERS WITH DIRECT, CONTINUOUS ACCESS TO PRINTED COMPANY MATERIALS AND PROMOTIONAL MERCHANDISE, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 9-0-2001; IN COMMERCE 9-0-2001.

OWNER OF U.S. REG. NOS. 1,208,208, 1,963,905, AND OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "PRINTING PROMOTIONS E-SOLUTIONS", APART FROM THE MARK AS SHOWN.

SN 76-304,880, FILED 8-24-2001.

AISHA CLARKE, EXAMINING ATTORNEY

Int. Cls.: 16, 35 and 42

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38, 50, 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 2,712,821

Registered May 6, 2003

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**

CONNECT WITH THE POWER OF...PROFORMA

PROFORMA, INC. (OHIO CORPORATION)
8800 E. PLEASANT VALLEY ROAD
CLEVELAND, OH 44131

FOR: BUSINESS FORMS AND DOCUMENTS, NAMELY, ANNOUNCEMENTS, ANNUAL REPORTS, BADGES, BINDERS, BROCHURES, BROCHURE COVERS, BUSINESS CARDS, BUSINESS REPLY CARDS, CALENDARS, CATALOGUES, CERTIFICATES, COUNTER CARDS, COUPONS, COUPON BOOKS, DOOR HANGERS, FLYERS, FOLDERS, FILE FOLDERS, PRESENTATION FOLDERS, GIFT CERTIFICATES, INDEX TABS, INVITATIONS, LETTERHEAD, MAILERS, MANUALS, MEMO PADS, NEWSLETTERS, PAMPHLETS, PARKING TICKETS, POSTERS, PRESSURE TAPE, PROGRAMS, RACK BROCHURES, SELL SHEETS, SOFTWARE DOCUMENTATION, TAGS, TICKETS, TRANSFER TAPE, WALL CALENDARS, BLANK, PARTIALLY PRINTED AND PRINTED LABELS, PAPER TAGS, STATIONARY ENVELOPES, BLANK CHECKS, SALES LEDGER BOOKS, PRINTED TICKET BOOKS AND CASH RECEIPT BOOKS, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 5-1-2001; IN COMMERCE 5-1-2001.

FOR: ADVERTISING SERVICES, NAMELY, THE SELECTION AND IMPRINTING OF ITEMS MANUFACTURED BY OTHERS TO BE USED BY THE

CUSTOMERS AS GIVE-AWAYS, PROMOTIONAL ITEMS OR SALE; AND FRANCHISING SERVICES, NAMELY, ASSISTANCE IN THE ESTABLISHMENT AND OPERATION OF BUSINESSES SPECIALIZING IN THE SALE AND DISTRIBUTION OF BUSINESS FORMS, PROMOTIONAL PRODUCTS AND COMMERCIAL PRINTING, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 5-1-2001; IN COMMERCE 5-1-2001.

FOR: COMMERCIAL PRINTING SERVICES AND BUSINESS ASSISTANCE SERVICES, NAMELY, DESIGNING AND IMPLEMENTING INTERACTIVE ON-LINE WEBSITES FOR OTHERS TO PROVIDE EMPLOYEES AND CUSTOMERS OF OTHERS WITH DIRECT, CONTINUOUS ACCESS TO PRINTED COMPANY MATERIALS AND PROMOTIONAL MERCHANDISE, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 5-1-2001; IN COMMERCE 5-1-2001.

OWNER OF U.S. REG. NOS. 1,208,208, 1,963,905 AND OTHERS.

SER. NO. 76-304,881, FILED 8-24-2001.

BRIAN RUPP, EXAMINING ATTORNEY